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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/532,023

04/20/2005

Kazuya Maekawa

APA-0220

6143

74384

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03/17/2009

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EXAMINER

DEXTER, CLARK F

ART UNIT

PAPER NUMBER

3724

MAIL DATE

DELIVERY MODE

03/17/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/532,023	<b>Applicant(s)</b> MAEKAWA ET AL.	
	<b>Examiner</b> Clark F. Dexter	<b>Art Unit</b> 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,6,7,11 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,8-10 and 13-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 May 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 24, 2008 has been entered.

### ***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 2, 5, 8-10 and 13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 11-12, the recitation "the existing scribe line" lacks positive antecedent basis.

### ***Claim Rejections - 35 USC § 102/103***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3724

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 2 and 13-15 are rejected under 35 U.S.C. 102(b) as anticipated by any one of Shimotoyodome, pn 6,460,258, pn 6,470,782, pn 6,478,206 (hereafter the Shimotoyodome patents) or, in the alternative, under 35 U.S.C. 103(a) as obvious over any one of the Shimotoyodome patents in view of Zumstein, pn 3,834,258.

The Shimotoyodome patents each discloses a scribe apparatus with every structural limitation of the claimed invention as best understood from the claims including:

a scribe means for generating a high-penetration vertical crack in the brittle material substrate by applying impacts of a short period to the point on the surface of the brittle material substrate; and

Art Unit: 3724

a travel motion control means (e.g., 50, and the moving mechanism that causes vertical movement of the scribe means) for controlling the travel motion of the scribe means, wherein said travel motion control means prevents said scribe means from traveling across the point of intersection between the scribe lines of the first and second directions (e.g., when the moving mechanism that causes vertical movement in the prior art moves the cutter away from the workpiece, the scribe means is prevented from traveling across the workpiece and thus would be prevented from moving across an existing scribe line and/or a point of intersection).

Regarding claims 13-15, these claims set forth an intended use of the prior art apparatus and the prior art apparatus is/are fully capable of performing the recited functions.

In the alternative, if it is argued that a travel motion control means pertains to or otherwise requires a computer programmed to cut a specific pattern or patterns (e.g., to cut perpendicular or transverse lines that do not intersect), more specifically one “that prevents said scribe means from traveling across the point of intersection between the scribe lines of the first and second directions,” the Examiner takes Official notice that the use of such programmable computers with scribing or scoring devices is old and well known in the art and provides various well known benefits including automatic operation of the scribing or scoring device. Zumstein discloses one example that teaches using a computer for controlling a scribing/scoring device (e.g., see the paragraph bridging columns 8-9). Therefore, it would have been obvious to one having ordinary skill in the art to provide such a programmable computer in combination with

Art Unit: 3724

the scoring/scribing devices of the Shimotoyodome patents for cutting any desired pattern.

***Allowable Subject Matter***

6. Claims 1, 5 and 8-10 are allowable over the prior art of record.

***Response to Arguments***

7. Applicant's arguments filed December 24, 2008 have been fully considered but they are not persuasive. Regarding the prior art rejection, the Examiner respectfully disagrees with applicant's position. However, it is further noted that there is no recitation of any "programming" requirement in the claims, and thus it is respectfully submitted that the recited function(s) must be considered to be a functional recitation of intended use, particularly since the prior art is fully capable of performing the recited function(s). Still further, it is respectfully submitted that while the addition of such "programming" language in the claim may not be persuasive, it would appear to strengthen applicant's position on this issue.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

Art Unit: 3724

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Clark F. Dexter/  
Primary Examiner, Art Unit 3724**

cfd  
March 14, 2009